

### REMARKS

This is a full and timely response to the non-final Official Action mailed **January 12, 2005**. Reconsideration of the application in light of the above amendments and the following remarks is respectfully requested.

By the forgoing amendment, the specification and various claims have been amended. Additionally, new claims 35-41 have been added and original claims 7, 27 and 34 have been cancelled. Claims 17-21 have been withdrawn under a previous Restriction Requirement. Thus, claims 1-6, 8-16, 22-26, 28-33 and 35-41 are currently pending for the Examiner's consideration.

The outstanding Office Action rejected claims 1-8, 14-16, 22, 26-28 and 32-34 as anticipated under 35 U.S.C. § 102(b) by U.S. Patent No. 5,930,553 to Hirst et al. ("Hirst"). Alternatively, the same claims were rejected as anticipated under 35 U.S.C. § 102(e) by U.S. Patent No. 6,735,399 to Tabb et al. ("Tabb"). For at least the following reasons, these rejections are respectfully traversed.

Claim 1 recites: "A method of providing firmware for a printing device, said method comprising attaching a memory module storing said firmware to a printing device consumable, wherein said memory module contains said firmware and a firmware interface object." (emphasis added).

Applicant's specification explains and defines the claimed "firmware interface" as follows.

In addition to the firmware code (103), a firmware interface (104) may be included with the firmware components (102) on the memory module (110). The firmware interface (104) can be uploaded to the memory of a printing device to allow the printing device to access and execute the firmware code (103) while the firmware code (103) remains stored on the memory module (110) and is not uploaded to the

memory of the host printing device. The firmware interface (104) may also provide the host printing device with details about the different objects of firmware code (103) available on the module (110), such as the size, location, version number, purpose, etc. of each object of firmware code. This information can be used by the host printing device to determine whether or not to upload the objects of firmware code (103) from the memory module (110). (Applicant's spec., para. 0022).

In contrast, neither Hirst nor Tabb teach or suggest the claimed firmware interface object in a memory module attached to a printing device consumable. Neither Hirst nor Tabb mention or describe anything similar to the claimed firmware interface object.

"A claim is anticipated [under 35 U.S.C. § 102] only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987) (emphasis added). See M.P.E.P. § 2131. For at least this reason, the rejection of claims 1-6 based on Hirst or Tabb should be reconsidered and withdrawn.

Similarly, independent claim 14 recites:

A method for executing firmware code for a printing device using a printing device consumable, said method comprising:  
storing firmware code on a memory module;  
attaching said memory module to a printing device consumable;  
installing said printing device consumable with attached memory module in a printing device; and  
uploading a firmware interface for said firmware code to a printing device memory.  
(emphasis added).

In contrast, as demonstrated above, the Hirst and Tabb references do not contain any concept of a firmware interface as disclosed and claimed by Applicant. Specifically, Hirst and Tabb fail to teach or suggest the claimed method including "uploading a firmware interface for said firmware code to a printing device memory."

"A claim is anticipated [under 35 U.S.C. § 102] only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987) (emphasis added). See M.P.E.P. § 2131. For at least this reason, the rejection of claims 14-16 based on Hirst or Tabb should be reconsidered and withdrawn.

Similarly, independent claim 22 recites:

A consumable for use with a printing device, said consumable comprising:  
a printing device consumable;  
a memory module attached to said printing device consumable; and  
firmware components stored on said memory module;  
wherein said firmware components comprises firmware code and a firmware interface for allowing access and use of said firmware code on said memory module.  
(emphasis added).

In contrast, as demonstrated above, the Hirst and Tabb references do not teach or suggest a firmware interface as disclosed and claimed by Applicant. Specifically, Hirst and Tabb fail to teach or suggest the claimed consumable including firmware components in an attached memory module including a firmware interface for allowing access and use of the firmware code on the memory module.

"A claim is anticipated [under 35 U.S.C. § 102] only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987) (emphasis added). See M.P.E.P. § 2131. For at least this reason, the rejection of claim 22 and its dependent claims based on Hirst or Tabb should be reconsidered and withdrawn.

Independent claim 28 recites:

A printing device that allows access and use of firmware components stored on a memory module attached to a printing device consumable comprising:  
a printing device controller;  
a printing device memory; and  
a printing device interface disposed and configured to interface and communicate with said memory module attached to a printing device consumable supplied to said printing device;

wherein said printing device controller is configured to upload a firmware interface object from said memory module and use said firmware interface to access additional firmware on said memory module.

(emphasis added).

In contrast, as demonstrated above, the Hirst and Tabb references do not contain the concept of a firmware interface as disclosed and claimed by Applicant. Specifically, Hirst and Tabb fail to teach or suggest the claimed printing device with a printing device controller “configured to upload a firmware interface object from said memory module and use said firmware interface to access additional firmware on said memory module.”

"A claim is anticipated [under 35 U.S.C. § 102] only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987) (emphasis added). See M.P.E.P. § 2131. For at least this reason, the rejection of claim 28 and its dependent claims based on Hirst or Tabb should be reconsidered and withdrawn.

Claims 9, 10, 12 and 13 were rejected as unpatentable under 35 U.S.C. § 103(a) over the teachings of Hirst or Tabb in combination with those of U.S. Patent No. 6,820,039 to Johnson et al. (“Johnson”). Claim 11 was rejected as unpatentable under 35 U.S.C. § 103(a) over the teachings of Hirst or Tabb in combination with those of Johnson and U.S. Patent No.

6,807,388 to Kojima et al. ("Kojima"). These rejections are respectfully traversed for at least the following reasons.

The Johnson patent was filed April 19, 2002 and issued November 16, 2004. Consequently, Johnson qualifies as prior art against the present application, which was filed July 8, 2003, only under 35 U.S.C. § 102(e). The Johnson patent and its subject matter are owned by Hewlett-Packard Co. The Johnson patent was assigned to Hewlett-Packard Co. on April 14, 2002 and then to the Hewlett-Packard Development Company on January 31, 2003. (*See*, Reel 013776, Frame 0928). The invention of the present application then was made under an obligation of assignment to Hewlett-Packard Co. and has since also been assigned to the Hewlett-Packard Development Company. (*See*, Reel 014092, Frame 0365).

35 U.S.C. § 103(c) states:

Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Consequently, the Johnson reference cannot be applied as prior art against the present application under 35 U.S.C. § 103. Therefore, the rejections of claims 9-13, based in part on Johnson, must be reconsidered and withdrawn.

Claims 23-25 and 29-31 were rejected under 35 U.S.C. § 103(a) over the teachings of Hirst or Tabb in combination with those of Japanese Patent Publication No. 2002-62769.

This rejection is respectfully traversed for at least the following reasons. As demonstrated above, independent claim 22, from which claims 23-25 depend, and independent claim 28, from which claims 29-31 depend, are patentable over the prior art of record. Consequently, dependent claims 23-25 and 29-31 are thought to also be clearly patentable over the prior art

of record for at least the same reasons given above in support of their respective independent claims 22 and 28.

The newly-added claims are thought to be patentable over the prior art of record for at least the same reasons given above with respect to the original claims. Therefore, examination and allowance of the newly-added claims is respectfully requested.

For the foregoing reasons, the present application is thought to be clearly in condition for allowance. Accordingly, favorable reconsideration of the application in light of these remarks is courteously solicited. If the Examiner has any comments or suggestions which could place this application in even better form, the Examiner is requested to telephone the undersigned attorney at the number listed below.

Respectfully submitted,

DATE: 1 April 2005



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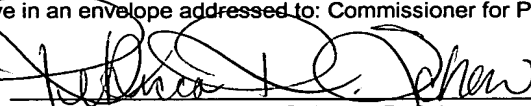
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**CERTIFICATE OF MAILING**

DATE OF DEPOSIT: April 1, 2005

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail on the date indicated above in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.



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